

BAKER BOTTS LLP.

A33864-090495.0232
PATENT

#10
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6/11/03



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Goldsmith *et al.*
Serial No. : 09/918,873 Examiner: Nashed, Nashaat T.
Filed : July 31, 2001 Group Art Unit: 1652
For : CHIMERIZING PROTEIN KINASES FOR DRUG DISCOVERY

RESPONSE TO RESTRICTION REQUIREMENT

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Assistant Commissioner for Patents, Washington, D.C. 20231

June 4, 2003
Date of Deposit

Alicia A. Russo
Attorney Name

Alicia A. Russo
Signature

46,192
PTO Registration No.

June 4, 2003
Date of Signature

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Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Restriction Requirement dated May 15, 2003, please consider the following remarks.

The Examiner asserts that that the present application contains three distinct inventions, grouped as follows:

Group A: Claims 1-24 and 34-40 drawn to a chimeric protein kinase

comprising part of a first protein kinase and part of a second protein kinase (select one first protein kinase and one second protein kinase), classified in class 435, sub-class 194;

Group B: Claims 25-31 drawn to a method of identifying an inhibitor of a first protein kinase using a chimeric kinase (select one first protein kinase and one second protein kinase), classified in class 435, sub-class 15; and

Group C: Claims 32 and 33, drawn to a protein kinase binding site (select one binding site), classified in class 530, sub-class 350.

In the Office Action, the Examiner has contended that the inventions are distinct because (1) the chimeric proteins of A are independent chemical entities and require different searches in the patent and non-patent literature, (2) the inventions of B are unrelated, and (3) the protein kinase binding sites of C are independent chemical entities and require different searches in the patent and non-patent literature. The Examiner further alleges that the inventions of A and B are distinct because the chimeric protein kinases of A and the methods of B, respectively are related as product and process of use, which are distinct if the process for using the product can be practiced with a different product or if the product as claimed can be used in a different process. The Examiner further alleges that the chimeric protein kinases of A and the binding sites of C are unrelated because they are different chemical entities, and similarly alleges that the methods of B and the binding sites of C are unrelated.

Applicants respectfully traverse the restriction. Applicants assert that the

Examiner has improperly imposed a restriction requirement within the Groups to a specific first protein kinase and a specific second protein kinase. Applicants believe that an election of species is proper in the particular instance.

The requirement imposed by the Examiner improperly forces a restriction within a single claim, thereby forcing the applicants to file one-hundred thirty-four (134) patent applications (63 for each Group A and B and 8 for Group C) to cover all of the chimeric protein kinases in all groups. It has long been held that the Office may not impose a restriction requirement within a single claim. See *In re Watkinson*, 14 USPQ.2d 1407 (Fed. Cir. 1990) citing *In re Weber*, 198 USPQ 328, 332 (CCPA 1978) and *In re Haas*, 198 USPQ 334, 336 (CCPA 1978). The courts have definitively ruled that the statute authorizing restriction practice (i.e. 35 U.S.C. § 121), provides no authority to impose a restriction requirement within a single claim, even if the claim presents multiple independently patentable inventions. In these cases, the courts expressly ruled that there is no statutory basis for rejecting a claim for misjoinder, despite previous attempts by the Office to fashion such a rejection. As noted in *In re Weber*:

The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim, no matter how broad, which means no matter how many independently patentable inventions may fall within it.

In re Weber at 334.

Furthermore, alleging that a particular claim represents multiple

“patentably distinct” inventions is a *de facto* rejection of the patentability of the claim because the claim cannot issue as drafted. In this regard the courts have noted:

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not effect the rights of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim will never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner, rather than the applicant, it is not inconceivable that a number of fragments would not be described in the specification.

See In re Weber, supra, emphasis added.

Here, it should be clear that the exorbitant costs of filing 134 patent applications, which would be required by the present restriction requirement, does not strike an appropriate balance between the administrative concerns of the Office and the applicants’ statutory rights as inventors. Accordingly, Applicants respectfully request withdrawal of the restriction requirement within the three Groups.

Should the Examiner find the traversal persuasive, Applicants elect Group C for prosecution on the merits, without prejudice to pursuing the subject matter of the other groups in divisional applications.

Should the Examiner not find the traversal persuasive, in order to be fully

responsive, Applicants further provisionally elect Group C and the protein kinase p38 with traverse.

Applicants believe that no fee is due with this response. However, should any fees be required in connection with this response, the Commissioner is hereby authorized to charge Deposit Account Number 02-4377. A duplicate copy of this communication is enclosed.

Respectfully submitted,

BAKER BOTTS L.L.P.



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BAKER BOTTS LLP

Attorney Docket Number: A33864 090495.0232

Title: CHIMERIZING PROTEIN KINASES FOR DRUG DISCOVERY



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1652

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Please type a plus sign (+) inside this box → ☐

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	09/918,873
Filing Date	July 31, 2001
First Named Inventor	Elizabeth J. Goldsmith
Group Art Unit	1652
Examiner Name	Nashed, Nashaat T.
Attorney Docket Number	A33864 090495.0232

ENCLOSURES (check all that apply)

- | | | |
|---|---|--|
| <input type="checkbox"/> Fee Transmittal Form
<input type="checkbox"/> Fee Attached
<input checked="" type="checkbox"/> Amendment / Reply
<input type="checkbox"/> After Final
<input type="checkbox"/> Affidavits/declaration(s)
<input type="checkbox"/> Extension of Time Request
<input type="checkbox"/> Express Abandonment Request
<input type="checkbox"/> Information Disclosure Statement
<input type="checkbox"/> Certified Copy of Priority Document(s)
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Assignment Papers (for an Application)
<input type="checkbox"/> Drawing(s)
<input type="checkbox"/> Licensing-related Papers
<input type="checkbox"/> Petition
<input type="checkbox"/> Petition to Convert to a Provisional Application
<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address
<input type="checkbox"/> Terminal Disclaimer
<input type="checkbox"/> Request for Refund
<input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Status Letter
<input type="checkbox"/> Other Enclosure(s) (please identify below): |
|---|---|--|

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	BakerBotts LLP 30 Rockefeller Plaza New York, NY 10112	
Signature		Att Name: Alicia A. Russo PTO Reg: 46,192
Date	June 4, 2003	

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on this date: June 4, 2003

Typed or printed name	Alicia A. Russo	
Signature		Date June 4, 2003

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FEE TRANSMITTAL for FY 2003

Effective 01/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$0)

Complete if Known

Application Number 09/918,873
 Filing Date July 31, 2001
 First Named Inventor Elizabeth J. Goldsmith
 Examiner Name Nashed, Nashaat T.
 Art Unit 1652
 Attorney Docket No. A33864 090495.0232

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METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☐ Deposit Account:

 Deposit Account Number
 Deposit Account Name

02-4377

Baker Botts LLP

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments

☐ Charge any additional fee required under 37CFR 1.16 and 1.17

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	750	2001	375	Utility filing fee	
1002	330	2002	165	Design filing fee	
1003	520	2003	260	Plant filing fee	
1004	750	2004	375	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$0)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
20	0	0	0
3	0	0	0
Multiple Dependent			

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	84	2201	42	Independent claims in excess of 3
1203	280	2203	140	Multiple dependent claim, if not paid
1204	84	2204	42	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$0)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description
1051	130	2051	65	Surcharge - late filing fee or oath
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet
1053	130	1053	130	Non-English specification
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action
1251	110	2251	55	Extension for reply within first month
1252	410	2252	205	Extension for reply within second month
1253	930	2253	465	Extension for reply within third month
1254	1,450	2254	725	Extension for reply within fourth month
1255	1,970	2255	985	Extension for reply within fifth month
1401	320	2401	160	Notice of Appeal
1402	320	2402	160	Filing a brief in support of an appeal
1403	280	2403	140	Request for oral hearing
1451	1,510	1451	1,510	Petition to institute a public use proceeding
1452	110	2452	55	Petition to revive - unavoidable
1453	1,300	2453	650	Petition to revive - unintentional
1501	1,300	2501	650	Utility issue fee (or reissue)
1502	470	2502	235	Design issue fee
1503	630	2503	315	Plant issue fee
1460	130	1460	130	Petitions to the Commissioner
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)
1806	180	1806	180	Submission of Information Disclosure Stmt
8021	40	8021	40	Recording each patent assignment per property (times number of properties)
1809	750	2809	375	Filing a submission after final rejection (37 CFR 1.129(a))
1810	750	2810	375	For each additional invention to be examined (37 CFR 1.129(b))
1801	750	2801	375	Request for Continued Examination (RCE)
1802	900	1802	900	Request for expedited examination of a design application

Other fee (specify)


*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$0)

SUBMITTED BY

(Complete if applicable)

Name (Print/Type) Alicia A. Russo Registration No. 46,192 Telephone 212.408.2627
 Signature Date June 4, 2003

PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)		Docket Number (Optional) A33864 090495.0232
	In re Application of	
	Application Number 09/918,873	Filed July 31, 2001
	For CHIMERIZING PROTEIN KINASES * see attached	
	Group Art Unit 1652	Examiner Nashed, Nashaat T.

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.

The requested extension and appropriate non-small-entity fee are as follows (check time period desired):

☐ One month (37 CFR 1.17(a)(1))

☐ Two months (37 CFR 1.17(a)(2))

☐ Three months (37 CFR 1.17(a)(3))

☐ Four months (37 CFR 1.17(a)(4))

☐ Five months (37 CFR 1.17(a)(5))

☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee amount shown above is reduced by one-half, and the resulting fee is: \$_____.

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account.

☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 02-4377.

I have enclosed a duplicate copy of this sheet.

I am the ☐ applicant/inventor

☐ assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).

☐ attorney or agent of record.

☐ attorney or agent under 37 CFR 1.34(a).
Registration number if acting under 37 CFR 1.34(a) _____.

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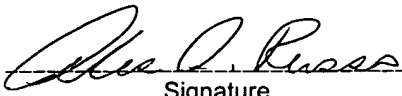
\$ _____

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

June 4, 2003

Date

PTO Reg No.: 46,192



Signature

Alicia A. Russo

Typed or printed name

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ Total of _____ forms are submitted.